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**AFTER FINAL  
EXPEDITED PROCEDURE  
EXAMINING GROUP 2672**

**PATENT**  
Customer No. 22,852  
Attorney Docket No. 9090.0002-03

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Darin Wayne HIGGINS et al.

Application No.: 09/821,172

Filed: March 29, 2001

For: **SYSTEM AND METHOD FOR  
SYNCHRONIZING RASTER AND  
VECTOR MAP IMAGES**

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) Group Art Unit: 2672

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) Examiner: Javid A. Amini

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Assistant Commissioner for Patents  
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**REQUEST FOR RECONSIDERATION**

This Request for Reconsideration is in response to the Examiner's Official Action dated April 23, 2003. Claims 1-20 are currently pending in the present application. The following remarks are submitted to be fully responsive to the Office Action. Reconsideration of this application in light of these remarks, and allowance of this application are respectfully requested.

I. **Rejection of Claims Under 35 U.S.C. § 103**

On page 4 of the Official Action, the Examiner rejected claims 1-21 under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 5,815,118 to Schipper (hereinafter,

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Schipper) in view of U.S. Patent No. 5,848,373 to DeLorme et al. (hereinafter, DeLorme).

The present invention as recited in independent claim 1 is directed to a system for automatically manipulating or annotating a second map when a first map is manipulated or annotated, the system comprising: a map display; a map processing platform in communication with the map display, wherein said map processing platform is adapted to: receive a user annotation at a first location on a first map; and update a second map with the user annotation at a location on the second map that corresponds to said first location; a storage platform coupled to the map processing platform; and a user interaction device coupled to the map processing platform.

5 The Examiner appears to admit that Schipper fails to disclose the step of receiving a user annotation at a first location on a first map, but he provides that "[t]he step of user annotation is obvious because at a location on the first map (old map) will update a second map (new map), this can be considered as a manipulation of annotation." (April 23, 2003 Official Action at page 5). The Examiner also admits that:

Schipper does not explicitly specify the user interaction, however DeLorme teaches in abstract in addition the PDA/PC/EC may incorporate a user location system such as a GPS location system for displaying the location and route of the CAMLS user on the display see also Fig. 6. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of DeLorme into Schipper. . ."

(Id.)

Applicants respectfully disagree.

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. According to the Manual for Patent Examining Procedures (MPEP), the mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. (MPEP § 2143.01) The MPEP further provides that the rationale to modify the prior art does not have to be expressly stated in the prior art; it may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. (See id. at § 2144)

14 In this case, the Examiner has not provided any basis for his conclusion that it would have been obvious to modify the method disclosed in Schipper to include a map processing platform adapted to receive a user annotation at a first location on a first map. In fact, the suggestion that the modification is obvious is directly contradicted by the fact that Schipper specifically teaches away from receiving a user annotation on a first map when it provides that "[t]he location coordinates of two or more landmarks from an old map 109 are entered into a computer 111, using a keyboard or other data entry device 113. (Schipper at col. 30, lines 3-6.) (emphasis added.) In Schipper, the location coordinates are the user's relative bearings to the two or more landmarks. Once the device in Schipper receives the user-inputted coordinates, it uses those coordinates and the user's location as computed by an LDS, to more accurately depict the user's location on a map. There is no suggestion that the device in Schipper could perform its function by relying on a user annotation at a first location on the map since the device in Schipper requires relative bearings from a user's location to two or more

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landmarks in order to update the map with the user's location. Indeed, based on the manner in which Schipper updates the user's location, it appears that modifying the Schipper method in the manner proposed by the Examiner would render that method inoperative. Thus, a person of ordinary skill would not have been motivated to modify Schipper in the manner proposed by the Examiner.

Even if the Examiner's proposed combination of Schipper and DeLorme is within the capabilities of one of ordinary skill in the art, it would still fail to teach or suggest all the claim elements. That is, even if Schipper could compute a user's coordinates to two or more landmarks simply from a user annotation on a map, Schipper does not teach, disclose or suggest the capability to update a second map with an annotation at a location on the second map that corresponds to the first user annotation, as recited in independent claim 1. Schipper, as shown above, expressly teaches receiving user-inputted coordinates of two or more landmarks into a computer. Once the device in Schipper receives the user-inputted coordinates, it uses those coordinates and a user's location computed by an LDS to accurately depict the user's location on the map. In other words, the device in Schipper updates the map at a position that is unrelated to the location coordinates of the landmarks inputted by the user. Schipper does not teach, disclose or suggest updating a second map with the user annotation at a location on the second map that corresponds to the first location.

In rejecting independent claims 17, 18 and 20, the Examiner incorrectly relies on the limitations recited in claim 1. A careful reading of those claims reveals that they are of a different scope than claim 1. More specifically, claim 17 recites an apparatus capable of manipulating a map comprising: means for determining a boundary of a

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geographic region of a first map; means for converting the boundary of the geographic region of the first map into a corresponding boundary of a second map; and means for configuring the boundary of the second map for display. Claims 18 and 20 recite a method and computer-readable medium, respectively, of correlating a map annotation between a first map and a second map, the second map being geographically substantially similar to the first map, the method comprising: detecting an annotation entry on the first map; associating the annotation entry with a set of first map coordinates; associating the set of the first map coordinates with a set of second map coordinates; and enabling the display of the annotation entry on the second map. The Examiner does not argue, and Schipper does not teach or suggest the apparatus recited in claim 17, the method recited in claim 18, or the computer-readable medium recited in claim 20.

DeLorme fails to make up for the shortcomings of Schipper. With respect to claim 1, the Examiner does not argue and DeLorme does not teach or suggest the capability to: (1) receive a user annotation at a first location on a first map; or (2) update a second map with the user annotation at a location on the second map that corresponds to said first location, as recited in claim 1. With respect to claims 17, 18 and 20, the Examiner does not argue, and DeLorme does not teach or suggest the capability to: detect an annotation entry on a first map; associate the annotation entry with a set of first map coordinates; associate the set of first map coordinates with a set of second map coordinates; or enable the display of the annotation entry on the second map. Therefore, the rejection of independent claims 1, 17 and 18 under § 103(a) as unpatentable over Schipper in view of DeLorme is improper and should be withdrawn.

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The rejection of dependent claims 2-16, 19 and 21 should also be withdrawn as they directly or indirectly depend on allowable subject matter as recited in the independent claims from which they directly or indirectly depend.

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 23, 2003

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